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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/702,611      | 11/07/2003  | William Richard Dubrul | 021016-1            | 8512             |

7590

04/07/2005

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| EXAMINER |
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AMERSON, LORI BAKER

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| ART UNIT | PAPER NUMBER |
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3764

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/702,611

Applicant(s)

DUBRUL ET AL.

Examiner

L. Amerson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 and 17 is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12-15 is/are rejected.
- 7) ☒ Claim(s) 8-11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1-7-05
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

***Response to Amendment***

1. The indicated allowability of claim 14 is withdrawn in view of the newly discovered reference(s).

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

a. Claims 1, 3 and 5-7, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Illustro in view of Duty. Illustro discloses a geometric element (fig. 1) having a flat bottom (11) a top (12) and a spring element (15) between the top and bottom (fig. 1) whereby the distance from the top to the bottom varies with the amount of force applied on the device. Illustro discloses all of the limitations of the claimed invention except for a compressible covering. Duty teaches a compressible covering (fig. 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a covering over a device in order to provide comfort to a user while exercising. As to claims 5-7, the recitations have not been given patentable weight because the limitations are purely functional in nature and does not recite any structure. Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural

limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). As to claim 12, the device is assembled from components (12, 16 and 20).

**b.** Claims 1-3 and 5-7, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing in view of Duty. Downing discloses a geometric element having a flat bottom a top and a spring element between the top and bottom (fig. 1) whereby the distance from the top to the bottom varies with the amount of force applied on the device. Downing discloses all of the limitations of the claimed invention except for a compressible covering. Duty teaches a compressible covering (fig. 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a covering over a device in order to provide comfort to a user while exercising. As to claim 2, the spring element is a continuous loop. As to claims 5-7, the recitations have not been given patentable weight because the limitations are purely functional in nature and does not recite any structure.

**a.** Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hardee as applied to claim 1 above, and further in view of Mason et al. Hardee discloses all of the limitations of the claimed invention except for the spring being an inflatable bag. Thus, Mason et al teach an inflatable bag. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hardee in view of Mason et al such that an inflatable bag can be substituted as a spring element.

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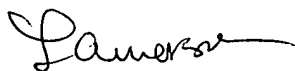
3. Claims 8-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 16-17 is allowed.

***Conclusion***

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the device of Yarbrough.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to L Amerson whose telephone number is (703) 306-5576. The examiner can normally be reached on Mon.-Fri from 8-5 p.m. Interviews Tue. and Thur..

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



L. Amerson